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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,625	12/18/2001	Ian D. McRury	022956-71 (MIT-239)	3998

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EXAMINER

EREZO, DARWIN P

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,625

Applicant(s)

MCRURY ET AL.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,20,21 and 23-34 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,20,21 and 23-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Species II in the reply filed on 12/23/05 is acknowledged.
2. Claim 8 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/23/05.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation of "a weldable material is provided between at least one electrode and at least one length of suture". This limitation suggests that there is an additional weldable material in addition to the "first and second lengths of suture" recited in the independent claim 1. However, it is unclear in the specification as to what constitutes as the third "weldable material". It appears to the Examiner that the limitations of claim 7 has in fact been previously amended to claim 1 in the recitation of "first and second lengths of suture". Therefore, it is suggested that claim 7 be cancelled to obviate the rejection under 112.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 20, 21, 23-25 and 27-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,662,068 to Polonsky.

As to claim 1, Polonsky teaches a suture welding system comprising an electrical energy source for producing radio frequency (RF) waves (col. 1, line 36); a first and second lengths of suture (the individual strands of suture beyond the knot seen in Fig. 6); a suture welding device comprising a working end (the jaws **20,22**) having a suture contacting element (surface 28); a first electrode electrically coupled to the electrosurgical energy source and disposed on the suture contacting element (internally, col. 2, lines 33-37); and a second electrode electrically coupled to the electrical energy source and disposed proximate the suture welding site for providing a return electrical energy path (the other surface 30); wherein the RF energy welds the suture together. As seen in Fig. 5, the electrodes within each jaw are coupled electrically to the energy source.

As to claim 3, the jaws are fully capable of providing a variable gap between the surfaces.

As to claims 20 and 21, Polonsky teaches the method for welding sutures together, the method comprising providing an electrosurgical energy source (col. 1, line

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36); providing a suture welding device comprising a working end (the jaws **20,22**) having a suture contacting element (surface 28); a first electrode electrically coupled to the electrosurgical energy source and disposed on the suture contacting element (internally, col. 2, lines 33-37); and a second electrode electrically coupled to the electrical energy source and disposed proximate the suture welding site for providing a return electrical energy path (the other surface 30); placing a first and second length of suture into contact with the suture contracting element; a first and second lengths of suture (the individual strands of suture beyond the knot seen in Fig. 6); and providing RF energy to weld the sutures together.

As to claims 4, 23, 24 and 27, the jaws are fully capable of being in an open or closed position; and wherein the suture contacting element forces the sutures together.

As to claims 25, 28 and 29, Polonsky teaches at least one pod (58 or 60).

As to claim 30, see the rejection to claim 1 above.

As to claim 31, see the rejection to claim 3 above.

As to claims 32-33, see the rejections to claims 4 and 27 above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, 26 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polonsky in view of US 4,052,988 to Doddi.

Polonsky is silent with regards to the material forming the suture. However, Doddi teaches a surgical suture that is made of polydioxanone, which provides desirable properties, such as improved strength, smoothness, and pliability. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to make Polonsky's suture out of polydioxanone because this material has many surgically desirable properties such as tensile strength and pliability, as taught by Doddi.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 3-6, 20, 21, 23-26 and 27-34 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GLENN K. DAWSON  
PRIMARY EXAMINER